



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: **NISHIUCHI, Takeshi et al.**

#13  
Reg. for  
Recon  
M. Chapman  
5-2003

Group Art Unit: 3723

Serial No.: 09/901,044

Examiner: **MORGAN, E.P.**

Filed: **July 10, 2001**

P.T.O. Confirmation No.: **6430**

For: **DRY SURFACE TREATING APPARATUS AND DRY SURFACE TREATING METHOD USING THE SAME APPARATUS**

**REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION**

**BOX AF**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

TC 2700 MAIL ROOM  
MAY 19 2003  
May 14, 2003  
**RECEIVED**

Sir:

In response to the Office Action dated January 17, 2003, applicants request favorable reconsideration of the above-identified application. Claims 1-28 are pending.

Claims 1-21 and 23-28 were rejected under 35 USC §103(a) as being unpatentable over Pletscher in view Steube. The rejection is respectfully traversed.

The Examiner acknowledges that Pletscher does not show a porous surface or a plurality of barrels around a rotational axis. Steube is applied by the Examiner for its teaching of an apparatus having a mesh porous peripheral surface and a plurality of barrels. The Examiner argues that it would have been obvious to modify Pletscher to include a mesh porous surface "in order to filter out abraded debris from workpiece." Applicants respectfully traverse the rejection.

References are not properly combinable or modifiable if their intended function is destroyed. The combination/modification proposed by the Examiner would destroy the intended function of Pletscher.

Pletscher provides a shell or drum 1 rotatably mounted upon support rolls. The inner surface of the shell 1 is lined with a coating or covering 3 formed of rubber, plastic, wood or some other suitable material, the covering 3 being provided with a rib or grooving arrangement extending approximately in the lengthwise direction of the shell 1 and formed by the depressions in the form of grooves or troughs 4 and the raised portions in the form of ribs or protruberences 5 (see column 5, lines 1-29). Due to rotation of the shell, the particles are upwardly entrained through a certain angle of rotation by the entrainment means formed by the grooves 4 and the ribs 5 as a function of the properties of the inner grooving and rib arrangement of the shell, the magnitude or the size of the particles and the centrifugal force acting upon the particles.

Accordingly, it would not even appear possible to replace the shell of Pletscher with a mesh porous surface so as to filter out abraded debris, unless the coating or covering 3 of Pletscher is eliminated. Elimination of the covering 3, however, would destroy the intended functions discussed above.

It appears that it may be the Examiner's position that one of ordinary skill in the art would have employed a mesh porous surface having the same shape as the coating or covering 3 disclosed by Pletscher. However, *prima facie* obviousness requires a reasonable expectation of success. There does not appear to be a reasonable expectation of success to fulfill the intended function of Pletscher while employing a mesh porous surface.

The Examiner's position appears to be that it would be obvious to try the modification or combination of references, but an obvious to try standard does not establish *prima facie* obviousness. One can not base obviousness upon what a person skilled in the art might try or might find obvious to try, but rather must consider what the prior art would have lead a person skilled in the art to do. Clearly, the combination proposed by the Examiner would not lead to or suggest the claimed invention.

Claim 22 was rejected under 35 USC §103(a) as being unpatentable over Pletscher in view of Steube and further in view of Kanouse. Kanouse is applied by the Examiner for its disclosure of a blasting nozzle. This rejection is respectfully traversed.

Kanouse fails to provide the teachings which Pletscher and Steube lack, as discussed above. Still further, the combination of Kanouse with Pletscher and Steube would also destroy the intended function of Pletscher. That is, Pletscher provides the grooves 4 and the ribs 5 to form a particle elevating or lifting means so that the workpieces are subjected to a falling stream of particles which descend from the top toward the bottom of the shell 1. The use of the blasting nozzle would appear to destroy the function of the grooves 4 and ribs 5.

For at least the foregoing reasons, the claimed invention distinguishes over the cited art and defines patentable subject matter. Favorable reconsideration is earnestly solicited.

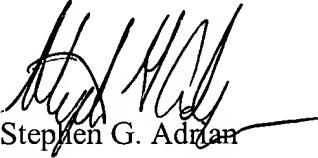
Should the Examiner deem at any further action by applicants would be desirable to place application in condition for allowance, the Examiner is encouraged to telephone applicants' undersigned attorney.

U.S. Patent Application Serial No. 09/901,044

In the event that this paper is not timely filed, applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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Enclosure: Petition for Extension of Time